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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/847,182	05/01/2001	Stephen G. Baker	D5154	5097

30409 7590 09/30/2003

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EXAMINER

WYROZEBSKI LEE, KATARZYNA I

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 09/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

AS

Advisory Action	Application No. 09/847,182	Applicant(s) BAKER ET AL.	
	Examiner Katarzyna Wyrozebski Lee	Art Unit 1714	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 03 September 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see the attachment to the advisory.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.

Claim(s) objected to: none.

Claim(s) rejected: 1-15.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

EDWARD J. CAIN
PRIMARY EXAMINER
GROUP 1500



Attachment to the Advisory Action

In the response to final office action mailed on September 3, 2003 applicants argued that the examiner made an improper final office action as follows.

In the first office action dated 11/8/2002, claims 1,2,4-8 and 10-15 were rejected over Brander '269 in obviousness type rejection. Claims 3 and 9 in the same first office action on the merits were rejected over Brander '269 as applied to claims 1, 2, 4-8 and 10-15 in further view of Brander '973. In the final office action dated 6/4/2003 in paragraph 3 the examiner has rejected claims 1-15 over the prior art of Brander '269 in view of Brander '973. The applicants have argued that the rejection stated in final office action is improper by stating that there is nothing that properly communicates the reasoning of the Brander references and continues to teach the examiner how the 103 rejections should be applied by submitting copy of the MPEP.

The applicants are therefore requested to review the heading of the paragraph 10 of the office action mailed on 11/8/2003. The heading states:

1. *Claims 3 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brander (US 5,911,269) as applied to claims 1, 2, 4-8, 10-15 above, and further in view of Brander (US 4,735,973).*

The discussion of the disclosure of the prior art of Brander '269 from paragraph 9 of this office action is incorporated here by reference..."

The final office action is proper for the following reasons, in short it restates already existing rejection of the same claims over the same prior art. Instead of writing two separate paragraphs the entire rejection is condensed into one. Therefore the applicants have been given more than fair opportunity to reply to the final office action. If applicants felt that the office action was not clear a simple phone call would have made that clear.

The applicants have stated that the declaration by Stephen Baker clearly overcame any conclusions of *prima facie* obviousness of claims 1, 2, 4-8 and 10-15.

At the very beginning of the final office action mailed on 6/4/2003 the examiner made it clear that the declaration of Mr. Baker did not overcome the rejection of record. The declaration submitted by the prior art of Stephen Baker discusses differences between the lake sand and silica sand. On page 3 of the declaration Mr. Baker the discussion of the two composition comprising silica sand and lake sand gives no clear differences, for example between terms like castings without significant veining and castings with substantially no veining? What is the difference between the two? Also the examiner stated that the MSDS submitted with the declaration was not readable and examiner was not fully able to make any conclusions. In fact the examiner requested that the MSDS be resubmitted. In addition lake sand is not a limitation present in the independent claims.

With respect to the examiner's comment about applicants not fully addressing the rejection, the examiner will agree that the applicant on page 11 of the response received on

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2/20/2003 discussed in one short paragraph what the prior art of Brander '279 and Brander '973 do not teach when compared to the present invention. However the secondary reference of Brander '973 was not utilized to reject entire application. Brander '973 was utilized to provide for limitations of claims 3 and 9, which is the limitation of lake sand, which even now is not part of independent claim. The applicants did not argue why it would not have been obvious to combine the two prior art disclosures.

If the applicants still feel that a further clarification is required they are more than welcome to contact the examiner. Such issued would be fixed much faster with proper communication.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katarzyna Wyrozebski Lee whose telephone number is (703) 306-5875. The examiner can normally be reached on Mon-Thurs 6:30 AM-4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (703) 306-2777. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Katarzyna Wyrozebski
KIWL
September 24, 2003

EDWARD J. CAIN
PRIMARY EXAMINER
GROUP 1500
Ed